UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/542,139	04/04/2000	Satoru Yukie	50 P 3859.02	6059

36738   7590   07/13/2009
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EXAMINER
POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
3696	

MAIL DATE	DELIVERY MODE
07/13/2009	PAPER

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1   UNITED STATES PATENT AND TRADEMARK OFFICE
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4   BEFORE THE BOARD OF PATENT APPEALS
5   AND INTERFERENCES
6   _____
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8   *Ex parte* SATORU YUKIE, GINA C. EUBANKS, and KEN AOKI
9   _____
10
11   Appeal 2008-004698
12   Application 09/542,139
13   Technology Center 3600
14   _____
15
16   Decided:[1] July 13, 2009
17   _____
18
19 *Before* ALLEN R. MACDONALD,[2] *Vice Chief Administrative Patent*
20 *Judge*, MURRIEL E. CRAWFORD, and HUBERT C. LORIN,
21 *Administrative Patent Judges*.
22
23 CRAWFORD, *Administrative Patent Judge*.
24
25
26   DECISION ON APPEAL

_____

[1]The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

[2] Judge Allen R. MacDonald replaces Judge David B. Walker who was on the original panel.

1   The original Decision entered February 27, 2009 is hereby

2   VACATED due to a clerical error noted on page 6 with regards to claim 24.

3   We hereby enter a new Decision on Appeal to correct this error.

4

5   STATEMENT OF THE CASE

6   Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection

7   of claims1 to 5, 8, 10, 12 to 17, 22, 24, 26, and 29 to 35. We have

8   jurisdiction under 35 U.S.C. § 6(b) (2002).

9   Appellants invented a computer system having at least one connect

10   server accessing a database of publicly vended content to fulfill requests and

11   at least one billing module for generating accounting data based on at least

12   one of a request for content received, each piece of content delivered, a

13   content subscription, a type of user terminal and a number of IP packets

14   delivered (Specification 4).

15   Claim 1 under appeal reads as follows:

16   1.   A computer system, comprising:
17   a computer network path, at least a portion of which is
18   wireless:
19   at least one user terminal in the path;
20   at least one connect server communicating with the user
21   terminal, the connect server receiving requests for content
22   generated from the user terminal, the connect server accessing a
23   database of publicly vended content to fulfill the requests; and
24   at least one billing module accessible to the connect
25   server for generating accounting data based on at least one of:
26   each request for content received, each piece of content
27   delivered to the user terminal, a content subscription, a type of
28   user terminal, and a number of IP packets delivered to the user
29   terminal.
30

1   Claim 12 under appeal reads as follows:

2   12.   A method for vending content, comprising the acts of:

3   rendering the content in a digitized format;

4   making the content available on a computer network;

5   establishing at least one network path between the

6   network and a user terminal, at least a portion of the path being

7   a private wireless path;

8   sending the content to the user terminal via the network

9   path; and

10   generating accounting data representative of the

11   provision of content to the user terminal; wherein the

12   accounting data is based on at least one of:

13   a number of packets delivered to the user terminal; and

14   a type of the user terminal.

15

16   The Examiner rejected claims 1 to 5, 8, 10, 12 to 17, 22, 24, 26, and

17 29 to 35 under 35 U.S.C. § 102(b) as being anticipated by Hylton.[3]

18   The prior art relied upon by the Examiner in rejecting the claims on

19 appeal is:

20 Hylton   US 5,708,961   Jan. 13, 1998

21

22   ISSUES

23   Have Appellants shown that the Examiner erred in finding that Hylton

24 discloses a connect server as required by claim 1?

25   Have the Appellants shown that the Examiner erred in finding that

26 Hylton discloses a method including the step of generating accounting data

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[3]Claim 29 does not appear to comply with the requirements of 35 U.S.C. §
112, second paragraph because the claim is dependent on a canceled claim.
In the event the Appellants decide to further prosecute the application before
the Examiner, a correction should be made.

1   based on at least one of a number of packets delivered to the user terminal

2   and the type of user terminal as required by claim 12?

3

4   FINDINGS OF FACT

5   FF 1. Hylton discloses a computer system comprising a computer

6   network path for providing broadband signals to a number of set top boxes

7   or user terminals 100 (col. 4, ll. 54 to 57; Figure 1). The system distributes

8   signals utilizing wireless transmission between a shared processing system

9   10 and the user terminals 100 (col. 4, ll. 57 to 60). The shared processing

10 system 10 is connected to and receives a plurality of channels from a digital

11 broadband network 5 (col. 5, ll. 41 to 42). For each user terminal on the

12 system there is a channel selector and a program selector (col. 5, ll. 58 to

13 60). The shared processing system 10 supplies broadband signals to a

14 number of user terminals. Hylton does not disclose that broadband network

15 5 includes a server or that broadband network 5 communicates with user

16 terminals 100 or accesses a billing module.

17   FF 2. Hylton discloses that billing for the broadband content may

18 take place using a subscription process or a pay per view process (col. 40, ll.

19 38 to 48; col. 27, ll. 12 to 14). Hylton discloses that a service profile is

20 created for each customer and their set top box and is stored in a level 1

21 gateway and that the level 1 gateway may provide interface to appropriate

22 billing systems (col. 26, ll. 9 to 15). Hylton does not disclose that billing is

23 based on the number of packets delivered or the type of user terminal or that

24 the broadband network accesses a billing module.

25

1   PRINCIPLES OF LAW

2   To support a rejection of a claim under 35 U.S.C. § 102(b), it must be

3   shown that each element of the claim is found, either expressly described or

4   under principles of inherency, in a single prior art reference. *See Kalman v.*

5   *Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983), *cert. denied*, 465

6   U.S. 1026 (1984).

7

8   ANALYSIS

9   We will not sustain the Examiner's rejection because the Examiner

10   has not shown that each element of claims 1 and 12 is found expressly or

11   under principles of inherency in the Hylton reference.

12   In regard to claim 1, the Examiner finds that the broadband network 5

13   is a connect server as recited in claim 1 (Answer 4). As found above,

14   Hylton's broadband network 5 does not communicate with a user terminal or

15   a billing module. As such, broadband network 5 is not a connect server as

16   recited in claim 1. Hylton does not anticipate the subject matter of claim 1

17   and claims 2 to 5, 8, 10, 31, and 33 dependent thereon.

18   As such, we will not sustain this rejection as it is directed to claims 1

19   to 5, 8, 10, 31, and 33.

20   In regard to claims 12 and 26, we note that the customer in Hylton is

21   billed based on a subscription or on a pay per view basis. Although the

22   content sent to the user terminals may be sent in IP packets, there is no

23   disclosure that accounting is based on the IP packets. In addition, while

24   Hylton discloses that each user has a profile that includes a description of the

1   terminal type, there is no disclosure in Hylton that the accounting data is

2   based on the terminal type.

3   Therefore, we will not sustain this rejection as it is directed to claims

4   12 and 26 and claims 13 to 17, 22, 32, and 34 which are dependent on claim

5   12.

6   We will sustain this rejection as it is directed to independent claim 24

7   because this claim in reciting "at least one of" in line 7 only requires a

8   means for billing a user which includes a means for generating accounting

9   data based at least in part on a content subscription or on a request. Hylton

10   clearly shows that billing is based on a content subscription or on a pay per

11   view, i.e., based on a request. We will also sustain the rejection as it is

12   directed to claims 29 to 30 and 35 because the Appellants have not argued

13   the separate patentability of these claims.

14

15   CONCLUSION OF LAW

16   On the record before us, Appellants have shown that the Examiner

17   erred in finding that Hylton anticipates the subject matter of claims 1 to 5, 8,

18   10, 12 to 17, 22, 26, and 31 to 34.

19   On the record before us, Appellants have not shown that the Examiner

20   erred in finding that Hylton anticipates the subject matter of claims 24, 29,

21   30, and 35.

6

1   No time period for taking any subsequent action in connection with

2 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.

3 § 1.136(a)(1)(iv) (2007).

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5   <u>AFFIRMED-IN-PART</u>

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